

REMARKS/ARGUMENTS

Information Disclosure Statement

An Information Disclosure Statement was filed in the USPTO on January 18, 2006. However, a copy of form PTO/SB/08A suitably initialed by the Examiner was not received by the applicant. The Examiner is respectfully requested to consider the documents cited in the IDS and to return an initialed copy of the above-mentioned form to the undersigned indicating that such documents were considered and made of record.

Status of Claims

Claims 1-47 were examined. Of these, claims 7, 8, 26, 27, 43 and 44 have been canceled, without prejudice, and claims 48-50 have been added. Also, claims 1, 6, 20, 23, 33, 40 and 47 have been amended.

Overview of the Office Action

Claims 1-3, 5 and 9-47 have been rejected under 35 USC 102(e) as anticipated by Teshima. Claims 4 and 6-8 have been rejected under 35 USC 103(a) as being unpatentable over Teshima. Reconsideration and withdrawal of these rejections are respectfully requested in view of the claim modifications made herein and in light of the following remarks.

Summary of the Subject Matter Disclosed in the Specification

The specification discloses a technique for delivering a message based on position-determining technology. A sender creates a message and a delivery-location-dependent message delivery rule. According to one aspect, the system is a client-server arrangement and all the clients

are mobile objects and have a position-determining device. According to another aspect, the system is a peer-to-peer arrangement for users, with all the users being capable of transmitting as well as receiving messages. Various other distinctive and valuable features are disclosed which will become apparent from the following discussion.

Descriptive Summary of Teshima

Teshima discloses a mobile advertisement delivery system in which network navigation center 10 communicates with mobile communication instrument 12 carried by automobile 11. Advertisers use personal computers 18 to communicate over Internet 17 with network navigation center 10. The system enables an advertisement to be delivered to the mobile communication instrument 12 of an automobile 11 when it reaches a location designated by the advertiser.

Patentability of Independent Claims over Teshima

Claim 1:

Independent claim 1 recites a method to electronically deliver a message from a sender to an intended recipient based on tracking movement of a mobile object. A salient aspect of the claimed method is the feature of “enabling the sender and the intended recipient to send and receive an electronic deliverable message.” Both the send and the receive functionalities are made available to the intended recipient as well as to the sender.

Teshima discloses an arrangement in which personal computer 18 provides “various items of information including advertisement information ADI for delivering advertisements at locations designated for presenting advertisements selected by the ad sponsors and guide access information GAI for guiding the ad sponsor in inputting advertisement information ADI”. See para. [0047] of

Teshima. Thus, personal computer 18 can be compared to the claimed “sender” of the present application.

With the present claimed arrangement, any sender can also be an intended recipient, and vice versa. In contrast, Teshima does not disclose an arrangement in which the sender (i.e. personal computer 18) can also be an intended recipient. Consequently, this distinctive feature of the present invention which is explicitly recited in present claim 1 is not found in Teshima. Thus, Teshima cannot be an anticipatory reference under 35 USC 102.

Moreover, the above-mentioned distinctive feature of the present invention renders the present claimed arrangement fundamentally different from that disclosed in Teshima. Nothing can be pointed to in Teshima to suggest the use of such a feature or the motivation to do so. Accordingly, it is respectfully submitted that claim 1 is unobvious thereover and, thus, is patentable under 35 USC 103.

Claim 20:

Independent claim 20 is directed to a method for delivering a message with an electronic communication system servicing a plurality of clients in a client-server relationship. The claimed method includes the step of “providing each of the clients with a position-determining device”. In addition, claim 20 recites “obtaining, at the server, a message based on input from a first client.” Consequently, the message is obtained based on an input from one of the clients in the client-server relationship, and with such client being equipped with a position-determining device.

In contrast, Teshima provides no disclosure or teaching to indicate or even hint that personal computer 18, which generates the advertisement, is provided with a position-determining device. Consequently, this distinctive feature of the present invention which is explicitly recited in present

claim 20 is not found in Teshima. Thus, Teshima cannot be an anticipatory reference under 35 USC 102.

Moreover, the above-mentioned distinctive feature of the present invention renders the present claimed arrangement fundamentally different from that disclosed in Teshima. Nothing can be pointed to in Teshima to suggest the use of such a feature or the motivation to do so. Accordingly, it is respectfully submitted that claim 20 is unobvious thereover and, thus, is patentable under 35 USC 103.

Claim 23:

Independent claim 23 also includes the distinguishing features discussed above with respect to claim 20. Thus, claim 23 is allowable for reasons presented above with respect to claim 20.

Claim 28:

Independent claim 28 is directed to a method for automatically delivering a message electronically from a sender with a communication system servicing a plurality of potential recipients, and based upon position-determining technology. In particular, claim 28 contains the salient feature of “automatically delivering said message electronically to one of said intended recipients based upon the position of said one of the intended recipients relative to another of said intended recipients, as derived through the position-determining technology.” This feature is based on paragraphs [0050], [0087] and [0095] of the published application.

The Examiner contends that the above-mentioned salient feature of this claim is disclosed in sections [0015] and [0101] – [0102] of Teshima. However, a study by the undersigned of the sections relied upon by the Examiner failed to reveal any text which even remotely discloses the

subject feature of the present claimed invention. If the Examiner chooses to maintain the rejection of claim 28 on this basis, then he is respectfully requested to quote or at least point out the specific wording in the Teshima upon which the rejection is based.

It is respectfully submitted that this distinctive feature of the present invention which is explicitly recited in present claim 28 is not found in Teshima. Thus, Teshima cannot be an anticipatory reference under 35 USC 102.

Moreover, the above-mentioned distinctive feature of the present invention renders the present claimed arrangement fundamentally different from that disclosed in Teshima. Nothing can be pointed to in Teshima to suggest the use of such a feature or the motivation to do so. Accordingly, it is respectfully submitted that claim 28 is unobvious thereover and, thus, is patentable under 35 USC 103.

Claim 30:

Independent claim 30 includes the feature of “automatically triggering electronic delivery of said message to the intended recipient upon said second, mobile client being determined to have arrived at a designated position relative to the position of said third client.” The Examiner again points to sections [0015] and [0101] – [0102] of Teshima. However, those sections are completely lacking in any disclosure of the mentioned claimed feature. Consequently, Teshima cannot be an anticipatory reference for this claim. Moreover, this claim is clearly unobvious thereover.

Claim 33:

Independent method claim 33 includes the feature of “enabling the sender and the intended recipient to send and receive an electronic deliverable message.” Both the send and the receive

functionalities are made available to the intended recipient as well as to the sender. This feature has been discussed above with respect to claim 1. Thus, claim 33 is allowable for reasons presented above with respect to claim 1.

Claim 40:

Independent claim 40 is an apparatus claim which corresponds to method claim 1. Accordingly, apparatus claim 40 is allowable over Teshima for reasons presented above with respect to method claim 1.

Claim 41:

Independent apparatus claim 41 corresponds to method claim 20. Accordingly, apparatus claim 41 is allowable over Teshima for reasons presented above with respect to method claim 20.

Claim 42:

Independent apparatus claim 42 corresponds to independent method claim 23. Accordingly, apparatus claim 42 is allowable over Teshima for reasons presented above with respect to method claim 23.

Claim 45:

Independent apparatus claim 45 corresponds to independent method claim 28. Accordingly, apparatus claim 45 is allowable over Teshima for reasons presented above with respect to method claim 28.

Claim 46:

Independent apparatus claim 46 corresponds to independent method claim 30. Accordingly, apparatus claim 46 is allowable over Teshima for reasons presented above with respect to method claim 30.

Claim 47:

Independent apparatus claim 47 corresponds to independent method claim 33. Accordingly, apparatus claim 47 is allowable over Teshima for reasons presented above with respect to method claim 33.

Claim 48:

Independent claim 48 has been added. It corresponds to originally filed dependent claim 3 and, in particular, recites the distinctive features of “tracking a specified mobile object having a position-determining device that determines its own current position... wherein said specified mobile object is other than the intended recipient.” Thus, the delivery of the message is triggered by the movement of a mobile object, but the intended recipient is not this mobile object. This is disclosed in paragraphs [0037], [0080], [0096] and [0097] of the published application.

In commenting on claim 3, the Examiner contends that “Teshima teaches wherein the specified mobile object... is other than the intended recipient (Sections [0096]-[0100])”. However, a study by the undersigned of the sections relied upon by the Examiner failed to reveal any text which even remotely discloses the subject feature of the present claimed invention. If the Examiner chooses to reject claim 48 on this basis, then he is respectfully requested to quote or at least point out the specific wording in the Teshima upon which the rejection is based.

Claim 49:

Independent claim 49 has been added. Claim 49 corresponds to a combination of originally-filed claims 1, 9 and 10. In particular, claim 49 specifies that the message can be in “at least one of data, text, audio and video modes”, and further that “a mode in which said message is reproduced for the intended recipient is in accordance with a setting controlled by the intended recipient.” In commenting on claim 10, the Examiner contends that “Teshima teaches wherein a mode in which the message is reproduced for the intended recipient is in accordance with a setting controlled by the intended recipient (Sections [0046] – [0047] and [0086]. However, a study by the undersigned of the sections relied upon by the Examiner failed to reveal any text which even remotely discloses the subject feature of the present claimed invention. If the Examiner chooses to reject claim 49 on this basis, then he is respectfully requested to quote or at least point out the specific wording in the Teshima upon which the rejection is based.

Claim 50:

Independent claim 50 has been added. Claim 50 recites a “method to electronically deliver a message from a mobile sender to an intended recipient” as well as the step of “obtaining a message provided by the mobile sender.” Accordingly, claim 50 explicitly recites that the sender is a mobile sender. This is in contrast to Teshima in which no such feature is disclosed. Consequently, this distinctive feature of the present invention which is explicitly recited in present claim 50 is not found in Teshima. Thus, Teshima cannot be an anticipatory reference under 35 USC 102.

Moreover, the above-mentioned distinctive feature of the present invention renders the present claimed arrangement fundamentally different from that disclosed in Teshima. Nothing can

be pointed to in Teshima to suggest the use of such a feature or the motivation to do so. Accordingly, it is respectfully submitted that claim 50 is unobvious thereover and, thus, is patentable under 35 USC 103.

Patentability of Dependent Claims

Claims 2-6 and 9-19 depend from allowable claim 1. Thus, each of such dependent claims is allowable therewith. Moreover, these claims include features which serve to even more clearly distinguish the present invention over Teshima. For example, the Examiner's attention is drawn to the features of claims 3 and 10 which have been discussed hereinabove.

Claims 21 and 22 are allowable along with claim 20 from which they depend.

Claims 24 and 25 are allowable along with claim 23 from which they depend.

Claim 29 is allowable along with claim 28 from which it depends.

Claims 31 and 32 are allowable along with claim 30 from which they depend.

Claims 34-39 are allowable along with claim 33 from which they depend.

Conclusion

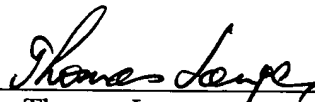
Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect and early passing of this application to issue are respectfully solicited.

Should the Examiner have any comments, suggestions or objections, he is respectfully requested to telephone the undersigned in order to facilitate a resolution of such outstanding issues.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By 
Thomas Langer
Reg. No. 27,264
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: June 26, 2006